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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,013	08/18/2003	Peter Spencer Edwards	TOMK:009A	2959

7590 11/03/2004

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EXAMINER

JOLLEY, KIRSTEN

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.	Applicant(s)	
10/643,013	EDWARDS, PETER SPENCER	
Examiner	Art Unit	
Kirsten C Jolley	1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 6-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/853,554.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/18/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of claims 1-5 in the reply filed on August 23, 2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Specification***

2. The disclosure is objected to because of the following informalities: A first paragraph of the specification should be added stating that the instant application is a continuation application of Application No. 09/853,554.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Domanik et al. (US 5,963,368).

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Domanik et al. discloses a method for applying information to a medical slide 14 wherein a printing medium is applied directly onto a surface portion 20a/21 of the slide 14 as identifier 22 (see Figure 3 and col. 3, lines 20-31). The printing medium of Domanik et al. is a wax that melts on the glass slide, therefore the medium is sealable onto the surface of the slide and is proof against removal or damage (col. 4, lines 45-46).

As to claim 5, Domanik et al. teaches applying a cover slip 18 (which is a solid medium) on top of the printing. The cover slip 18 would necessarily also act to seal the printed data on the medical slide.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Domanik et al. in view of Matzinger et al. (US 6,007,610).

Domanik et al. discloses a method for applying information to a medical slide 14 wherein a printing medium is applied directly onto a surface portion 20a/21 of the slide 14 as identifier 22 (see Figure 3 and col. 3, lines 20-31). As the printing medium, Domanik et al. teaches that another ink other than wax may be used for printing on the medical slide (col. 4, lines 41-47). One skilled in the art would have been motivated to look to the prior art for teachings of conventional ink jet inks that may be used in piezoelectric ink jet printers and may be applied on

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glass substrates for use in Domanik et al.'s process. Matzinger et al. discloses an ink jet ink which has high abrasion and scratch resistance, has high adhesion, and produces high quality images, and which may be used in a piezoelectric ink jet printer on glass substrates (col. 7). Matzinger et al. discloses that its ink composition comprises, among other ingredients, solvent and vinyl resin (col. 6, lines 15-33 and Examples). It would have been obvious for one having ordinary skill in the art to have used the ink jet ink composition of Matzinger et al. as the printing medium in the process of Domanik et al. since Matzinger et al.'s ink is taught to have high abrasion and scratch resistance, high adhesion, and high quality printing results. One would expect successful results since Domanik et al. specifically teaches that a conventional ink may be used if it is capable of printing on glass and is not limiting as to the specific ink that may be used. It is known that the ink jet ink of Matzinger et al. is sealable on the substrate and proof against removal or damage since Matzinger et al. teaches that the ink has high scratch and abrasion resistance and high adhesion.

As to claim 5, Domanik et al. teaches applying a cover slip 18 (which is a solid medium) on top of the printing. The cover slip 18 would necessarily also act to seal the printed data on the medical slide.


### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Thursday and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on 571-272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Kirsten C Jolley  
Primary Examiner  
Art Unit 1762

kcj